

II. REMARKS

United States Serial No. 10/520,239 was filed on July 18, 2005. Claims 16-35 are currently pending in the application.

Restriction Requirement

The Examiner requires restriction under 35 U.S.C. §§121 and 372 to one of the following inventions:

Group I: Claims 16-25, drawn to a ruthenium (II) compound of formula (I); and

Group II: Claims 26-35, drawn to a method of treating and/or preventing cancer by administering a therapeutically effective amount of a ruthenium (II) compound of formula (I).

It is alleged that the claims of Groups I and II do not relate to a single inventive concept under PCT Rule 13.1, because they allegedly lack the same or corresponding special technical feature.

Applicants respectfully disagree with the Examiner's position regarding the Carmona reference. The claimed ruthenium (II) compounds differ in chemical structure from those compounds described in the Carmona reference and therefore independent claims 16 and 22 are indeed novel over this reference. Therefore, the basis for the restriction requirement is erroneous.

Applicants hereby elect the claims of Group II (claims 26-35) for prosecution in the present application, and traverse the restriction requirement between Groups I and II.

The Examiner's attention is respectfully drawn to Section 10.24 – Example 4 set forth in the PCT Search and Examination Guidelines (PCT/GL/ISPE/1, Page 81), which is similar to the present situation:

10.24 - Example 4

Claim 1: Use of a family of compounds X as insecticides.

Claim 2: Compound X₁ belonging to the family X.

The PCT Search and Examination Guidelines clearly state that there is unity of invention between the subject matter of claims 1 and 2, provided that X₁ of claim 2 possesses insecticidal activity and the special technical feature in claim 1 is the insecticidal use.

In the present application, the claims of Group I are directed to certain ruthenium (II) compounds. The claimed ruthenium (II) compounds possess anticancer activity. The claims of Group II are directed to a method for treating and/or preventing cancer by administering a therapeutically effective amount of a ruthenium (II) compound.

Although drawn to a method for treating and/or preventing cancer, Applicants respectfully submit that the present application is quite similar to Example 4 of the PCT Search and Examination Guidelines where unity of invention was upheld. The ruthenium (II) compounds of claims 16-25 possess anticancer activity and claims 26-35 are drawn the use of ruthenium (II) compounds in a method for treating and/or preventing cancer.

For the reasons set forth hereinabove, Applicants respectfully submit that restriction is not proper in the present application, that the restriction requirement should be withdrawn, and that the claims of Groups I and II be rejoined for prosecution in the present application. In the event that the Examiner does not withdraw the restriction requirement, Applicants hereby reserve the right to file the claims of Group I in one or more divisional applications.

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Election of Species

It is also alleged that the application contains claims directed to more than one species of the generic invention, and that the species lack unity of invention. The species are as follows:

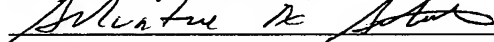
Species A: any compound according to formula (I) of claim 16 defined to contain individually specific functional groups with respect to each of R1 through R6, X, T, T', R, R1c and R3c as defined in claim 16; and

Species B: any compound according to formula (I) of claim 22 defined to contain individually specific functional groups with respect to each of R1 through R6, X, L, X[sic – should be “Y”] and X' [sic – should be “Y'”] as defined in claims 22 (or individually specific functional groups with respect to formulas (II) through (X) or formulas (XI) through (XV) of claims 30 and 31, respectively, or T, T', R, R1c, and R3c as defined in claims 32 in lieu of L, X [sic – should be “Y”] and X' [sic – should be “Y'”] as defined in claims 22.

Applicants hereby elect Species B. Applicants submit that claims 22 and 23-35 (in part) read on elected Species B.

Should there be any questions regarding the above amendments or remarks, Applicant's undersigned attorney would welcome a telephone call.

Respectfully submitted,



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